

REMARKSStatus of the Claims

No changes have been made to the claims in this amendment. Claims 1-6, 8-25, 27-34, and 38 remain pending in the application.

Advisory Action

On March 17, 2005, an Advisory Action was mailed in this case after the Examiner reviewed Applicants response date Feb. 11, 2005. The Examiner indicated that Claims 1-6, 8-25, and 27-32 are allowed, and Claims 33 and 34 are rejected. The Examiner further noted that Claim 38 is objected to as being dependent upon a rejected claim, but would be allowed if rewritten in independent form to include all of the limitations of the base claim and any intervening claim.

On page 3 of the Advisory Action, the Examiner acknowledged that in the previous Office Action, he had "objected to dependent claims 37, and 38 to further narrow the scope of independent claims." He acknowledged that in response thereto, applicants had canceled claims 36, and 37, and "amended claim 33 to include the limitation of claims 36, and 37, while claim 38 still stand as a claim objected to as being dependent upon a rejected base claim." He stated further that "as a result, cited prior art does implement and teaches a system and a method for players to host and join new instances of multiplayer online electronic games as broadly recited in claim 33."

In addition, the Examiner had rejected Claim 38 under 35 U.S.C. § 112, second paragraph, because "Claim 38 recites the limitation 'the recipient' in line 3" and "there is insufficient antecedent basis for this limitation in the claim. Applicants attorney was confused by the statements made in the Advisory Action, because these statements seem to be wrong and/or mutually inconsistent, for the following reasons.

In an Office Action dated April 21, 2004, under a heading "Allowable Subject Matter," the Examiner listed Claims 6 - 9, 22, 23, 37, and 38. After further prosecution, the Final Office action dated January 27, 2003 still list Claims 37 and 38 as claims to which the Examiner has objected. Since Claim 37 had been objected to in the Final Office Action as reciting patentable subject matter, the inclusion of the subject matter of Claim 37 in amended independent Claim 33 should have made Claim 33 patentable. Yet, in the Advisory Action, the Examiner had not allowed Claim 33.

Also, the response dated Feb. 8, 2005 amended Claim 33, subparagraph (e)(vii) to recite: "producing an audible announcement with said at least one sound transducer apprising a *recipient* of

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1 the electronic invitation that the host player has invited the recipient to join the chat session."
2 (Emphasis added.) In addition, Claim 38 was amended in that response to depend from Claim 33,
3 instead of Claim 37, since Claim 37 was canceled. Accordingly, Claim 38 should not have been
4 rejected under 35 U.S.C. § 112, second paragraph, for lack of antecedent basis for the phrase, "the
5 recipient," because antecedent basis is provided in Claim 33.

6 Summary of Telephone Interview

7 On April 8, 2005, applicants' attorney and Examiner Zia had a telephone interview.
8 Applicants' attorney wishes to thank Examiner Zia for agreeing to the Telephone Interview on short
9 notice and for his consideration of applicants' concerns raised during the interview.

10 In general, applicants' attorney and Examiner Zia discussed the rejection and the amendment
11 made to the claims and were in agreement about the facts regarding the Office Action content and the
12 nature of the amendments made to the claims of this application. However, Examiner Zia asserts that
13 Claim 33 as last amended is not patentable.

14 Based upon the discussion during the interview, it appears that the Examiner may have meant
15 to object to Claim 38, but not to Claim 37. Applicants' attorney acknowledged that since Claim 38
16 previously depended on Claim 37, if the Examiner had actually intended to object only to Claim 38 in
17 the Final Office Action and not also to Claim 37, then it would have been necessary to amend
18 Claim 33 to include the recitation from Claim 38 also, in order to make Claim 33 patentable.

19 However, applicants' patent attorney pointed out that the Final Office Action clearly indicates
20 that BOTH Claims 37, and 38 are objected to (i.e., separately objected to) and clearly indicates that
21 they both recite patentable subject matter. It was noted that on that basis, applicants in good faith
22 amended Claim 33 to include the recitation of Claims 36 and 37, because Claim 37 depended on
23 Claim 36, which depended on Claim 33, but chose not to include the recitation of Claim 38.
24 Applicants then canceled Claims 36 and 37. The amendment in the response to the last Office Action
25 should thus have placed all remaining claims in this application into condition for allowance.

26 After explaining that he had reviewed the case carefully and has concluded that Claim 33 is
27 not yet patentable, the Examiner suggested that applicants simply amend Claim 33 to include the
28 recitation of Claim 38 and cancel Claim 38. For the reasons noted below, applicants attorney is
29 unwilling to take this action at this time. Accordingly, it was decided by the Examiner and
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1 applicants' attorney that applicants should respond in writing to the Advisory Action, which has led
2 to this response being filed.

3 If, as it now appears, the Examiner actually intended to object ONLY to Claim 38 in the Final
4 Office Action and not both to Claims 37, and 38, applicants request that Examiner issue a new or
5 Revised Final Office Action so indicating, since on the written record now present in this application,
6 the case should have been allowed on the last response. Once applicants receive a new or Revised
7 Final Office Action, which indicates that the previous Final Office Action inadvertently stated that
8 both Claims 37 and 38 are objected to, applicants will likely respond by amending Claim 33 to
9 include the recitation of Claim 38, and canceling Claim 38. However, applicants are not willing to
10 take these steps until a written record actually is provided by the Examiner to state that the previous
11 Final Office Action incorrectly indicated both Claims 37 and 38 were objected to. Absent such
12 acknowledgement as to why a further amendment to the claims is required in this application, there is
13 simply no reason to make such an amendment. Failure to provide a clear written record of the
14 prosecution in an application can potentially have an adverse impact on any infringement action
15 subsequently brought after an application issues as a Letters Patent.

16 Alternatively, if on further reflection, the Examiner concludes that the claims as currently
17 amended have placed the application in condition for allowance, the Examiner is requested to allow
18 the application as last amended. Respectfully, it might be helpful for the Examiner to review this
19 matter with his Supervisory Examiner, for guidance on how best to proceed.

20 Respectfully submitted,

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25 FAX CERTIFICATE

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27 I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and
28 Trademark Office at facsimile number 703-872-9306, on April 12, 2005.

29 Date: April 12, 2005

30 *Linda Barrett*

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